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EXAMINER

KANERVO, VIRPI H

ART UNIT

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3691

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/577,610

**Applicant(s)**

GENDELMAN, SIMCHA

**Examiner**

VIRPI H. KANERVO

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16, 17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

#### **DETAILED ACTION**

1. Claims 1-14, 16-17, and 19-22, are presented for examination. Applicant filed an amendment on 02/19/2008 cancelling claims 15 and 18; amending claims 1-9, 11, 14, and 19; and adding new claims 20-22. In light of Applicant's amendments, Examiner withdraws the rejection of claims 1-14, 16-17, and 19. However, new grounds of rejection are established for claims 1-14, 16-17, and 19. New grounds of rejection are established for newly added claims 20-22. Since the new grounds of rejection were necessitated by Applicant's amendment of claims and adding of new claims, the rejection of claims 1-14, 16-17, and 19-22, is a FINAL rejection of claims.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-14, 16-17, and 19, have been fully considered, but are moot in view of new grounds of rejection necessitated by Applicant's amendment of claims.
3. Applicant's arguments with respect to claims 20-22 have been fully considered, but are moot in view of new grounds of rejection necessitated by Applicant's adding of new claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in § 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11, 14, and 20, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox (2002/0194122 A1) in view of Bonalle (2006/0020558 A1).

As to claim 1, Knox shows issuing, by a prepaid card issuer, a multiplicity of prepaid cards (Knox: page 1, ¶ 17 and page 2, ¶ 18), each bearing prepaid card identification indicia (Knox: Fig. 1, labels 105 and 106); inputting the prepaid card identification indicia of a prepaid card into a point of sale terminal (Knox: Fig. 1, labels 105, 106, 110, and 111); communicating said prepaid card identification indicia from the point of sale terminal to a remote server to validate said prepaid card (Knox: Fig. 1, labels 110, 111, and 150; and page 2, ¶ 18); and following receipt of acceptable validation from said remote server, processing a prepaid card transaction as a credit card transaction employing a credit card account

associated with said prepaid card issuer (Knox: page 2, ¶ 18). Knox does not show that credit card account is identified by a credit card number which is different from said identification indicia of said prepaid card. Bonalle shows that credit card account is identified by a credit card number which is different from said identification indicia of said prepaid card (Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by credit card account being identified by a credit card number which is different from said identification indicia of said prepaid card of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 2, Knox in view of Bonalle shows all the elements of claim 1. Knox also shows that said processing a prepaid card transaction includes charging said credit card account for the amount of said prepaid card transaction (Knox: page 2, ¶ 18). Knox does not show identifying said credit card account by said credit card number. Bonalle shows identifying said credit card account by said credit card number (Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by identifying said credit card account by said credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 3, Knox in view of Bonalle shows all the elements of claim 2. Knox also shows that said credit card account is charged for the amount of prepaid card transactions of at least a plurality of said multiplicity of prepaid cards (Knox: page 1, ¶ 17; and page 2, ¶ 18).

As to claim 4, Knox in view of Bonalle shows all the elements of claim 2. Knox also shows that said credit card identification indicia is stored at said point of sale terminal (Knox: Fig. 1, labels 110 and 111). Knox does not show that said credit card identification indicia is the credit card number. Bonalle shows that said credit card identification indicia is the credit card number (Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 5, Knox in view of Bonalle shows all the elements of claim 4. Knox also shows that said credit card identification indicia is accessed at said point of sale terminal using said prepaid card identification indicia (Fig. 1, labels 105, 106, 110, and 111). Knox does not show that said credit card identification indicia is the credit card number. Bonalle shows that said credit card identification indicia is the credit card number

(Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 6, Knox in view of Bonalle shows all the elements of claim 2. Knox also shows that said credit card identification indicia is stored at said remote server (Knox: Fig. 1, labels 110, 111, and 150; and page 2, ¶ 18). Knox does not show that said credit card identification indicia is the credit card number. Bonalle shows that said credit card identification indicia is the credit card number (Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 7, Knox in view of Bonalle shows all the elements of claim 6. Knox also shows that said credit card number is accessed at said remote server using said prepaid card identification indicia (Knox: Fig. 1, labels 110, 111, and 150; and page 2, ¶ 18). Knox does not show that said credit card identification indicia is the credit card number. Bonalle shows that said credit card identification indicia is the credit card number (Bonalle:

page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 8, Knox in view of Bonalle shows all the elements of claim 1. Knox also shows that said inputting comprises reading said prepaid card identification indicia (Knox: page 2, ¶ 18).

As to claim 9, Knox in view of Bonalle shows all the elements of claim 1. Knox also shows that said inputting comprises keying in said prepaid card identification indicia (Knox: page 2, ¶ 18).

As to claim 10, Knox in view of Bonalle shows all the elements of claim 1. Knox also shows that said acceptable validation comprises balance information (Knox: page 2, ¶ 18).

As to claim 11, Knox shows an input device operative to receive prepaid card identification indicia from a prepaid card issued by a prepaid card issuer (Knox: Fig. 1, labels 105, 106, 110 and 111); and a processor, operative to process a prepaid card transaction using the prepaid card as a credit card transaction employing a credit card account associated with



said prepaid card issuer (Fig. 1, label 150; and page 2, ¶ 18). Knox does not show a credit card number associated with a credit card account associated with said prepaid card issuer, which credit card number which is different from said prepaid card identification indicia. Bonalle shows a credit card number associated with a credit card account associated with said prepaid card issuer, which credit card number which is different from said prepaid card identification indicia (Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by a credit card number being associated with a credit card account associated with said prepaid card issuer, which credit card number which is different from said prepaid card identification indicia of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 14, Knox in view of Bonalle shows all the elements of claim 11. Knox also shows that said processor is operative to verify acceptable validity of said prepaid card identification indicia prior to processing said prepaid card transaction (Knox: page 2, ¶ 18).

As to claim 20, Knox in view of Bonalle shows all the elements of claim 11. Knox does not show that said point of sale terminal receives said credit card number from a remote server. Bonalle shows that said point of sale terminal receives said credit card number from a remote server (Bonalle:

page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by said point of sale terminal receiving said credit card number from a remote server of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

6. Claims 12-13, 16-17, and 19, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Bonalle, and further in view of Wu (2003/0046249 A1).

As to claim 12, Knox in view of Bonalle shows all the elements of claim 11. Knox in view of Bonalle does not show that said input device is a card reader. Wu shows that said input device is a card reader (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Bonalle by said input device being a card reader of Wu in order to provide means for reading the data contained on the prepaid card (Wu: page 3, ¶ 34).

As to claim 13, Knox in view of Bonalle shows all the elements of claim 11. Knox in view of Bonalle does not show that said input device is a keyboard. Wu shows that said input device is a keyboard (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified the system of Knox in view of Bonalle by said input device being a keyboard of Wu in order to permit the customer to input information concerning the purchase of the prepaid card (Wu: page 3, ¶ 34).

As to claim 16, Knox in view of Bonalle shows all the elements of claim 11. Knox in view of Bonalle does not show a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card. Wu shows a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Bonalle by a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

As to claim 17, Knox in view of Bonalle shows all the elements of claim 16. Knox in view of Bonalle does not show that said remote server is operative to communicate a balance in said prepaid card, via said communicator, to

said terminal. Wu shows that said remote server is operative to communicate a balance in said prepaid card, via said communicator, to said terminal (Wu: Fig. 2; and page 4, ¶¶ 40-41). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Bonalle by said remote server being operative to communicate a balance in said prepaid card, via said communicator, to said terminal of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

As to claim 19, Knox in view of Bonalle shows all the elements of claim 11. Knox does not show a storage device for storing said credit card identification indicia. Wu shows a storage device for storing said credit card identification indicia (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by a storage device for storing said credit card identification indicia of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34). Knox in view of Wu does not show that said credit card identification indicia is the credit card number. Bonalle shows that said credit card identification indicia is the credit card number (Bonalle:

page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by said credit card identification indicia being the credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

7. Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Bonalle, and further in view of Meier (2003/0102376 A1).

As to claim 21, Knox in view of Bonalle shows all the elements of claim 5. Knox does not show identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia. Meier shows identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia (Meier: page 2, ¶ 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia of Meier in order to provide card identifier indicator (Meier: page 1, ¶ 8). Knox in view of Meier does not show that said credit card identification indicia is the credit card number. Bonalle shows that said credit card identification indicia is the credit card number (Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified the method of Knox in view of Meier by said credit card identification indicia being the credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

As to claim 22, Knox in view of Bonalle shows all the elements of claim 7. Knox does not show identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia. Meier shows identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia (Meier: page 2, ¶ 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia of Meier in order to provide card identifier indicator (Meier: page 1, ¶ 8). Knox in view of Meier does not show that said credit card identification indicia is the credit card number. Bonalle shows that said credit card identification indicia is the credit card number (Bonalle: page 3, ¶ 47). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox in view of Meier by said credit card identification indicia being the credit card number of Bonalle in order to provide card identifier which may be used to complete the transaction (Bonalle: page 3, ¶ 46).

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Berardi (2005/0165695 A1) discloses system and method for payment using radio frequency identification in contact and contact and contact less transactions.

Cartmell (2205/0075985 A1) discloses voice authenticated credit card purchase verification.

Kumaki (2002/0013766 A1) discloses commercial settlement system with prepaid type credit card.

Lurie (2002/0178088 A1) discloses system and method for facilitating shopping.

Saunders (2005/0038736 A1) system and method for transmitting track 1/track 2 formatted information via radio frequency.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIRPI H. KANERVO whose telephone number is (571)272-9818. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Virpi H. Kanervo



Art Unit: 3691

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691